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OFFICE OF PETITIONS

In re Patent No. 6,463,803 :
Issue Date: October 15, 2002 :
Application No. 09/749,693 : DECISION ON PETITION
Filed: December 28, 2000 :
Attorney Docket No. PM 275339 ND-A050-US5DIV# :

This is a decision on the renewed petition filed June 20, 2011, requesting withdrawal of a terminal disclaimer filed in the above-identified application and replacement with a corrected terminal disclaimer.

The petition is **dismissed**.

A review of the application file history reveals that a terminal disclaimer was filed August 20, 2011, in the above-cited application wherein applicants disclaimed the terminal part of any patent granted on this application which would extend beyond the expiration date of United States Patent No. 5, 416,916. The terminal disclaimer was accepted and made of record. Patentees now file the instant petition requesting that the terminal disclaimer filed August 20, 2001, be withdrawn because of a typographical error in the patent number that was being disclaimed. The terminal disclaimer cited U.S. Patent No. 5,416,916 when it should have cited United States Patent No. 4,461,916. Patentees request that the incorrect terminal disclaimer be withdrawn and that corrected terminal disclaimer, filed June 20, 2011, be made of record.

It is noted that Section 1490(VII)(B) of the Manual of Patent Examining Procedure (MPEP) states, in pertinent part, that:

> The mechanisms to correct a patent - Certificate of Correction (35 U.S.C. 255), reissue (35 U.S.C. 251); and reexamination (35 U.S.C. 305) - are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner - e.g., intervening rights in the case of a reissue patent. See, e.g., *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477, 24 USPQ 308 (1935).
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> ...
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> Where a terminal disclaimer was submitted to overcome a nonstatutory double patenting rejection (made during prosecution of an application which has now issued as a patent), and the numbers for the patent being disclaimed in the terminal disclaimer were inadvertently transposed (e.g., 6,444,316 written as 6,444,136), a petition under 37 CFR 1.182 may be filed to withdraw the terminal disclaimer with the incorrect (transposed) patent number (recorded in the issued patent), and replace it with a corrected terminal disclaimer having the correct patent number. In this instance, the inadvertency is clear from the record. If the transposing error resulted in an earlier patent term expiration date than provided by the corrected terminal disclaimer, a statement must be included in the corrected terminal disclaimer to retain that earlier expiration date. The absence of such a statement will result in the Office declining to exercise its discretion to grant relief.

Based on the above-cited section of the MPEP, it is appropriate to grant the instant petition because: 1) the terminal disclaimer was submitted to overcome a non-statutory double patenting rejection; 2) the numbers for the patent being disclaimed in the terminal disclaimer were inadvertently transposed, and 3) a statement is included in the corrected terminal disclaimer to retain the earlier expiration date.

The petition must be dismissed, however, because the corrected terminal disclaimer is not signed by an appropriate party pursuant to 37 CFR 1.321, which states, in pertinent part:

> (b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:
>
> (1) be signed:
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> (i) by the applicant, or
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> (ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or
>
> (iii) if there is an assignee of record of the entire interest, by such assignee, or
>
> (iv) by an attorney or agent of record;
>
> (2) specify the portion of the term of the patent being disclaimed;
>
> (3) state the present extent of applicant's or assignee's ownership interest in the patent to be granted; and
>
> (4) be accompanied by the fee set forth in § 1.20(d).
>
> (c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:
>
> (1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;
>
> (2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and
>
> (3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

The terminal disclaimer filed June 20, 2011, is signed by Michael J. Schmidt, who is a registered agent, but it is not noted in USPTO records as being the attorney or agent of record in this matter. The renewed petition should be accompanied by either a document granting power of attorney to Mr. Schmidt, or a terminal disclaimer that is signed by one of parties provided in 37 CFR 1.321(b) above.

A copy of this decision is being sent to the address cited on the petition, however, all future correspondence will be mailed solely to the address of record until appropriate written instructions to the contrary are received.

Questions regarding this decision may be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
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Office of Petitions

cc:
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